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Urs Burckhardt

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EXAMINER

HEINCER, LIAM J

ART UNIT

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DELIVERY MODE

11/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### ***Status of the Claims***

The rejection of Claim 17 under 35 U.S.C. 112, first paragraph has been withdrawn. Claims 1-10 and 14-17 are still rejected under 35 U.S.C. 103(a) as in the previous office action.

### ***Response to Arguments***

Applicant's arguments, see page 2-3, filed November 5, 2008, with respect to the rejection of claim 17 under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. The rejection of claim 17 under 35 U.S.C. 112, first paragraph has been withdrawn. Applicant has shown proper support for the subject matter for claim 17 in at least Example 2 (the use of stearic acid shows support for a 17 member alkyl group).

Applicant's arguments filed November 5, 2008 have been fully considered but they are not persuasive, because:

A) Applicants argument that both Merger et al. and Aoki et al. teach lower alkyls in the preferred embodiments is not persuasive. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See MPEP §2123. The fact that the references do not exemplify the embodiments with longer chains is not insufficient to show that the references teach away from the claimed range. Additionally, Aoki et al. teaches a range that overlaps with the claimed range (3:32-39). In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 2144.05. As the applicant has provided no data that shows the criticality of the claimed range, this *prima facie* case of obviousness has not been overcome.

B) Applicants argument that Aoki et al. is only concerned with aromatic amines, and thus there is no expectation of success with aliphatic amines is not persuasive. A

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person having ordinary skill in the art at the time of invention would have had a reasonable expectation of success when reacting the aldehyde of Aoki et al. with the amine of Merger et al. As one of the two embodiments for the aldehyde of Aoki et al. (formula III) is the same as one of the two embodiments of Merger et al. (7:17-39), and both references involve the reaction of an aldehyde with a polyamine to form a polyaldimine, a person having ordinary skill in the art at the time of invention would have expected the second aldehyde embodiment of Aoki et al. to have reacted with the polyamine of Merger et al. Since one of the functional equivalents of Aoki et al. is capable of functioning in the invention, it would not be unreasonable to expect the second equivalent to function.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/

Supervisory Patent Examiner, Art Unit 1796

LJH

November 7, 2008